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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	13533.4033	6074
34313 7590 12/16/2008 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558				
EXAMINER				
PREBILIC, PAUL B				
ART UNIT		PAPER NUMBER		
3774				
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12/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/740,679

## Applicant(s)

CUMMING, J. STUART

## Examiner

Paul B. Prebille

## Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on November 4, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53-102 and 104-124 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99-102 and 104-124 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 58,60,62,64-71,75,76,78,79,81-84,87-89,92 and 96-98.

***Election/Restrictions***

Claims 58, 60, 62, 64-71, 75, 76, 78, 79, 81-84, 87-89, 92, and 96-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002 to prosecute Species IX (Figure 18). Claim 65 is dependent upon a withdrawn base claim so it is withdrawn even though the Applicant argued that it was drawn to the elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90-91, 93-95, 99-102, and 104-124 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new language "the haptics being elongated and rectangular in shape" lacks original support; see elected Figure 18. The written specification does not describe the haptics of Figure 18 as being elongated or rectangular in shape. Furthermore, the ordinary definition of "rectangular" requires 4 right angles; see MSN Encarta Online Dictionary definition of "rectangular" at: <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=186169>

9809. Figure 18 clearly does not have rectangular haptics. Rather, it has curved sides and angle that are not at 90 degrees.

There is no special definition for "rectangular" in the specification. Additionally, "rectangular" is used only once in the specification and only used to describe the lens body (33) of Figures 2 and 3. It is used on conjunction with the modifier "generally"; see the paragraph on page 33 of the specification. For these reasons, the Examiner asserts that the claim language lacks original support.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99, 102, 105, and 107-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuss et al (US 4,664,665). Reuss anticipates the claim language where:

- the optic as claimed is the primary portion (32) of Reuss;
- a biconvex optic is taught on column 1, lines 32-39 and column 6, lines 51-60;
- the groove as claimed is groove (66) of Reuss;
- the haptic as claimed is secondary portion (34) or (36); it is elongate in the direction of the groove and it has a rectangular cross-sectional shape, (see Figure 3);

- the lens is capable of movement because it is foldable and has the same design as claimed; see Figures 1 to 10 and column 3, line 66 et seq.

In particular, "haptic" is defined as "tactile" by Dorland's Illustrated Medical Dictionary online at the web address of:  
[http://www.mercksource.com/pp/us/cns/cns\\_hl\\_dorlands\\_split.jsp?pg=/ppdocs/us/comm](http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=/ppdocs/us/comm)  
[on/dorlands/dorland/four/000047159.htm](http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=/ppdocs/us/comm). Also, Merriam-Webster Online defines "haptic" as "relating to or based on the sense of touch" see the web address of <http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=haptic>. Since the secondary portions are at least capable of touching something and being palpated, these portions are "haptics" to the extent that this term can be give patentable weight. Furthermore, the Examiner asserts that the secondary portions are clearly plate haptics to the extent that they are flat, and thus, would not act as lenses to focus light. In other words, the secondary portions have all the properties that plate haptics do. The mere fact that the secondary portions are not called haptics does not mean that they are not haptics in both structure and function.

The term "near" (see line 13 of claim 53, for example) is interpreted as one of relative degree that is broad and does not preclude the structure of Reuss that is shown as being capable of being near the bag to the extent that this language can be given patentable weight.

Regarding claim 73, the anchors as claimed are met by the openings (68) of Reuss.

Regarding claim 77, the inner end has a groove in it so it is not as thick as the rest of the haptic.

Regarding claim 111, the haptics need not all be plate haptics so the knobs can be on the other haptics (42, 44) of Reuss.

Regarding claim 121, the claim language depends upon how the intraocular lens is inserted into the body. There is nothing preventing it from being used such that the "front" faces the retina and the "back" faces the cornea.

### ***Response to Arguments***

Applicant's arguments filed November 4, 2008 have been fully considered but they are not persuasive.

In response to the traversal of the Section 112, first paragraph rejection, the previous rejection has been withdrawn. However, the new amendment presents Section 112 issue anew.

With regard to the Section 102 rejection, the Applicant's Representative argues that the Examiner has called part of the optic the plate haptics and that there are no plate haptics in Reuss. However, the Examiner asserts that the Applicant's Representative has given the term "haptic" an unreasonably narrow interpretation. In particular, "haptic" is defined as "tactile" by Dorland's Illustrated Medical Dictionary online at the web address of:

[http://www.mercksource.com/pp/us/cns/cns\\_hl\\_dorlands\\_split.jsp?pg=ppdocs/us/comm/on/dorlands/dorland/four/000047159.htm](http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=ppdocs/us/comm/on/dorlands/dorland/four/000047159.htm). Also, Merriam-Webster Online defines

"haptic" as "relating to or based on the sense of touch" see the web address of

<http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=haptic>. Since the secondary portions are at least capable of touching something, these portions are "haptics" to the extent that this term can be give patentable weight. Furthermore, the Examiner asserts that the secondary portions are clearly plate haptics to the extent that they are flat, and thus, would not act as lenses to focus light. In other words, the secondary portions have all the properties that plate haptics do. The mere fact that the secondary portions are not called haptics does not mean that they are not haptics in both structure and function.

The Applicant implies that since Reuss patent does not disclose an accommodating intraocular lens that the claim language is not met in this regard. However, since the structure and capability of the intraocular lens of Reuss is that same as the claimed invention, the Examiner maintains that the claim language is fully met; see MPEP 2112 that is incorporated herein by reference thereto.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
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